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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,237	10/16/2003	Indran Naick	AUS920030687US1	9409
35525	7590	09/25/2007		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER VU, VIET DUY	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 09/25/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/687,237

Applicant(s)

NAICK ET AL.

Examiner

Viet Vu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8, 10-11, 13-16, 18-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1, 3-8, 10-11, 13-16, 18-19 and 21 is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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**Art Rejections:**

1. The text of 35 USC 102(e) not cited here can be found in the previous office action.

2. Claims 1, 3-6, 8, 10-11, 13-16, 18-19 and 21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ong et al, U.S. pat. Appl. Pub. No. 2004/0257346.

Per claim 1, Ong discloses a system and method for sending content from a first application to a second application comprising:

- a) responsive to detecting a user input indicating a selection of the content, copying the selection of the content to form captured/copied content (see par. 56);
- b) presenting a graphical user interface and automatically capturing/copying the selection of the content in response to user's selection of a transfer type through the graphical user interface (see par. 57-58);
- c) automatically sending the copied content to the second application (see par. 62) wherein sending the copied content further comprises initiating the second application, e.g., opening editor (see par. 29) or use email client (see par. 143).

Per claims 4 and 9-10, Ong's teachings encompass all claim limitations (see par. 22-29).

Per claims 3 and 5, Ong teaches implementing the data capturing and transferring function within the application program or the OS shell (see page 4, par. 65).

Per claim 6, Ong teaches initiating execution of the second application (e.g., opening an editor) by the data capturing process (see par. 29).

Claims 11, 13-16 and 18-19 are similar in scope as that of claims 1, 3-6, 8 and 10.

Per claim 21, Ong teaches initiating a second application automatically without further user input upon receiving a function selected by a user (see par. 57-58).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

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Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ong.

Ong teaches automatically initiating execution of the second application (e.g., opening an editor) by the data capturing process (see par. 29). Ong also teaches using a communication program (email) by the data transfer function (see par. 143). Ong does not explicitly teach initiating a communication program if the communication program is not currently executing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize such step of automatically executing the communication program (email client) in Ong because it would have enabled the data transfer function to use the communication program to send copied data to destination user (see par. 29 and 143).

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**Response to Amendment:**

6. Applicant's arguments filed on August 6, 2007 have been fully considered but they are moot in view of new ground of rejection set forth above.

Applicant asserts that claim 1 now distinguishes over Ong because it has been amended to include limitation of claim 2 that was not rejected over Ong.

The examiner submits that upon further review of Ong it has been found that Ong in fact discloses automatically initiation of second application by the data capture process as discussed in item 2 above.

**Conclusion:**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is 571-272-3977. The examiner can normally be reached on Monday through Friday from 7:00am to 4:00pm. The Group general information number is 571-272-2100. The Group fax number is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on 571-272-1915.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



VIET D. VU  
PRIMARY EXAMINER

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9/14/07